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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,079	10/15/2007	Dietmar Wagenschein	GOTZ-15	2721

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EXAMINER

BELLINGER, JASON R

ART UNIT	PAPER NUMBER
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3617

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,079	Applicant(s) WAGENSCHN, DIETMAR	
	Examiner Jason R. Bellinger	Art Unit 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2. The drawings are objected to because Figures 1-2 are not clear. It appears that these figures are photocopies of color photographs, and are blurry and lack detail. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

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pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: The term “centre” should be replaced with the term --center-- throughout the specification, for grammatical clarity.

Reference to claims 1 and 20 should be removed from page 2 of the specification, due to the fact that the disclosure cannot rely on the claims to describe the invention.

The list of reference characters should be removed from page 10 of the specification, given the fact that these reference characters have previously been described in the specification. Therefore, a list of reference characters is redundant.

It is unclear what is being described by the phrase “[2 illegible symbols]” in line 18 of page 4 of the specification.

Appropriate correction is required.

4. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Objections

5. Claims 1-23 are objected to because of the following informalities: The term --A-- should be inserted prior to the first term in line 1 of claims 1 and 19. The term --The-- should be inserted prior to the first term in claims 2-18 and 20-23. These corrections are for grammatical clarity.

The term “via” and the phrases “characterised in that” or “characterised by” should be removed from the claims, due to the fact that these terms and phrases lack any physical features of the invention.

Reference to Figure 5 should be removed from claim 12.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification lacks any disclosure of the materials to form the weight body besides zinc and steel. Furthermore, there is no disclosure of the

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weight body being formed of zinc, steel, copper, brass, tungsten, gold, silver, or alloys thereof, AND another material such as glass.

8. Claims 19-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In line 8 of claim 19, the limitation that the contact face is formed with a number "n= 3,4,5,..." is not enabled due to the fact that no upper bound is disclosed in the claim or the specification. Therefore, the metes and bounds of the claim cannot be determined.

Claim 20 includes the limitation of "o= 4, 6, 8,... etc" and "n= 3, 5, 7, ... etc." These limitations are not enabled due to the fact that no upper bound is disclosed in the claim or the specification. Therefore, the metes and bounds of the claim cannot be determined.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite due to the fact that it is unclear what is actually being claimed by the phrase “provided subsequently”. It appears that this phrase may be drawn to a method limitation in an apparatus claim, which would receive no patentable weight (See MPEP 2113).

Claim 1 is further indefinite due to the fact that it is unclear whether the “at least three lateral sections” set forth in line 9 is the same as the “plural consecutive lateral sections” previously set forth, or are additional elements of the invention.

Claim 2 is indefinite due to the fact that it is unclear whether the metallic materials are to be combined with the other “material or alloy harder than lead, including glass”.

Claim 7 is indefinite due to the fact that it is unclear what is actually being claimed by the limitations that the radii of curvature can be “smaller than infinite”.

Claim 10 is indefinite due to the fact that the limitation “at least three differently sized radii of curvature” is a double recitation. This limitation has been previously set forth in claim 9. Therefore, it is unclear whether this limitation set forth in claim 10 is the same as that previously set forth, or is an additional element of the invention.

Claim 12 is indefinite due to the fact that it is unclear how the radius of curvature of the lateral sections can form an “open polygonal section”. By definition, a “polygon” is a closed shape of any number of sides each connected at a corner. Therefore, it is unclear how a “polygonal section” can be “open”.

Claim 13 is indefinite due to the fact that it is unclear what is actually being claimed by the limitation of “hypothetical extensions”. It is unclear whether these

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elements actually exist in the invention. Furthermore, it is unclear which "lateral sections" are being referred to in line 2 of claim 13.

Claim 16 is indefinite due to the fact that it is unclear what is actually being claimed by the term "hypothetical". It is unclear whether this element actually exists in the invention.

11. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

12. Regarding claims 1, 19 and 22, the phrases "in particular" and "preferably" render the claims indefinite because it is unclear whether the limitation(s) following the phrases are part of the claimed invention. See MPEP § 2173.05(d).

13. Regarding claim 2, the phrase "including" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

14. The term "harder" in claim 2 is a relative term which renders the claim indefinite. The term "harder" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would

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not be reasonably apprised of the scope of the invention. No qualitative or quantitative limitations have been provided to clearly define this term.

15. The term "long" in claims 6 and 12 is a relative term which renders the claims indefinite. The term "long" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. No qualitative or quantitative limitations have been provided to clearly define this term.

16. Claim 8 recites the limitation "the radii of curvature" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim. This limitation has not been previously set forth in claim 1, from which claim 8 depends.

17. The term "smallest" in claim 8 and the term "largest" in claims 9 and 14 are relative terms which render the claims indefinite. The terms "smallest" and "largest" are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. No qualitative or quantitative limitations have been provided to clearly define this term.

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18. Claim 16 recites the limitation "identically formed lateral sections" in lines 2-3.

There is insufficient antecedent basis for this limitation in the claim. This limitation has not been previously set forth in the claims.

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20. Claims 1-14, 16, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Green et al. As best understood, Figure 4 of Green et al show a wheel balancing weight including a plurality of consecutive lateral sections that are connected with obtuse angle bends. The weight may be formed of steel. The lateral sections extend along different radii of curvature, with the central radius of curvature approaching infinity (i.e. being rectilinear). The lateral end sections have the smallest radii of curvature. Linear extensions of the lateral sections form acute angles with adjacent lateral sections.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claim 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al. Green et al does not specify that the clamping element is formed from spring steel. However, it is well known in the art that the securing clip (i.e. clamping element) of wheel weights is commonly formed from spring steel. Therefore, one of ordinary skill in the art at the time of the invention would have found it obvious to form the clamping element of Green et al from spring steel to provide predictable results.

Conclusion

23. The status of allowability of any claims not rejected under art is being withheld until those claims have been amended to be in proper idiomatic form.

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references show wheel weights having a radius of curvature.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason R. Bellinger whose telephone number is 571-272-6680. The examiner can normally be reached on Mon - Thurs (9:00-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason R Bellinger/
Primary Examiner
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